REMARKS

The Examiner has indicated the allowance of claims 9-15 and the Applicants thank the Examiner for the early indication of allowance of these claims. The Examiner has rejected claims 1-7 and 16 under 35 U.S.C. § 102(b) as being anticipated by Caplan et al. U.S. Patent No. 5,667,291 and has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Caplan et al. in view of Gonzalez U.S. Patent No. 5,307,094.

Anticipation requires the presence of a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 41, 45 (Fed. Cir. 1984).

Claim 1 (and, therefore, dependent claims 2-8) of the present application is directed to an illuminating magnifying device that includes, among other things, a housing that is adapted to encapsulate a power source, for instance a battery. Claim 16 also recites such a structure. This aspect of the invention allows the illuminating magnifying device to be portable so it can be used virtually anywhere, such as for tying flies while fishing away from an AC power source.

The Caplan et al. '291 patent discloses a power source that includes a connection, such as a wire, to a remote light source. The Caplan et al. patent does not disclose a housing with an encapsulated integrated power source for a light, and is intended for use in dental and medical applications. Certainly in those applications an AC power source is likely available, and having an apparatus that is portable would typically be a concern.

As amended, claims 1-8 and 16 all recite a housing that is adapted to encapsulate a power source. The Caplan et al. '291 patent does not disclose such a device, and, therefore, cannot be anticipatory of the claims in the present application.

In order to establish a prima facie case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). First, there must be some suggestion or motivation, either in references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference or references must teach or suggest all of the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First, the Caplan et al. '291 Patent is directed to an illumination assembly for dental and medical applications. The Gonzalez '094 Patent, used in the rejection of claim 8 of the present application, is directed to a sunglass raising and lowering apparatus. The structures and fields of the apparatuses shown in the respective cited references are much different from one another. There is no suggestion or motivation in the references or in the general knowledge to combine the teachings of the two cited references. Second, there would be no reasonable expectation of success. To simply add a power source such as a battery, and a housing for holding it, from a sunglass raising and lowering apparatus to the illumination assembly of Caplan et al. would not likely be successful. Third, the prior art references, even in combination, do not teach or suggest the structure in claims of the present application. There is no housing in either reference that is adapted to encapsulate a power source, such as a battery. Therefore, the invention as claimed in the present application would not have been obvious to one of ordinary skill in the art at the time of the invention.

For these reasons, the Applicants request that the Examiner withdraw the §§ 102 and 103 rejections of claims 1-8 and 16.

CONCLUSION

The Applicants submit that the present application is in condition for allowance, a notice of which is respectfully solicited.

Respectfully submitted,

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